UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,730	12/26/2000	Yoshikazu Kobayashi	369252/99	1971

30743 7590 06/21/2006		EXAMINER
WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.		SCHEIBEL, ROBERT C

11491 SUNSET HILLS ROAD	ART UNIT	PAPER NUMBER
SUITE 340	2616	
RESTON, VA 20190		

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/745,730	KOBAYASHI, YOSHIKAZU
	Examiner	Art Unit
	Robert C. Scheibel	2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 March 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

- Examiner acknowledges receipt of Applicant's Amendment filed 3/29/2006.

- Claims 1 and 4 have been amended.

- New claim 12 has been added.

- Claims 1-12 are currently pending.

Response to Arguments

1.   Applicant's arguments, see pages 5-8, filed 3/29/2006, with respect to the rejection of

claims 1-11 under 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

Applicant asserts 3 separate arguments regarding the rejection of claims 1-11.

On page 5, Applicant's first argument relates to the amended limitation added to claims 1

and 4. Applicant has added the limitation that a user having no knowledge of IP or LAN can

connect the telephone. Applicant asserts that Alexander's telephone controller requires a

knowledgeable user in order to operate. Applicant further asserts reasons as to why the Eastep

reference does not disclose this limitation. Examiner respectfully disagrees with Applicant's

first assertion that Alexander requires a knowledgeable user. Alexander uses DHCP to acquire

the IP address. As is well known in the art, this is a protocol for automatically obtaining network

information without intervention by the user. Alexander's description (see lines 20-41 of column

9 for example) supports this behavior. In this passage, the telephony equipment acquires the IP

address "when an IP telephony device is connected to LAN 20". Similar to the present

invention, the user in Alexander requires no IP or LAN knowledge; the user must merely be

capable of physically connecting the device (as in the present application). Since this limitation is disclosed in Alexander, Applicant's arguments regarding Eastep are moot.

On pages 5-7, Applicant's second argument focuses on the limitation of the ID comprising a domain name. In the first paragraph of this section, Applicant summarizes the previous rejection and asserts that the Examiner has trivialized this limitation. In the next paragraph, Applicant asserts that a person of ordinary skill in the art would not have combined Alexander and Eastep without the benefit of the present claims and specification. In the next paragraph, Applicant continues this argument and asserts that because Alexander already accomplishes the function of uniquely identifying the user with an IP address, there is no need to use another identifier. Examiner respectfully disagrees with these arguments. The previous rejection, repeated below, cited a motivation in the Eastep reference. Lines 34-55 of column 83 of Eastep clearly imply that the use of an address such as an email is more convenient than an IP address. As such, this is an improvement upon the method of Alexander; thus, Examiner maintains that one of ordinary skill in the art would have been motivated to modify Alexander with Eastep.

Further, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

On pages 7-8, Applicant sets forth the third portion of the argument. This argument

rebuts Examiner's modification to Alexander to combine the tables into one table. In the first

two paragraphs of this section, Applicant summarizes Examiner's position from the previous

office action. In the next paragraph, Applicant argues that modifying Alexander's tables would

add complexity to Alexander and cannot be characterized as reducing cost. Examiner

respectfully disagrees. As stated in the previous rejection and repeated below, the combination

of these tables would eliminate redundant pieces of information and thus reduce memory

requirements. Examiner also disagrees that combining these tables would increase system

complexity. In fact, this combination of tables should reduce complexity as all related

information would be found in one location, reducing the number of places in memory to be

accessed for a particular operation.

In the remaining paragraphs, Applicant reasserts arguments relating to claim 12

(previously presented as claim 1). For reasons stated above, Examiner believes the rejection in

view of Alexander and Eastep to be valid and this rejection is maintained herein.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims **1-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

6,798,767 to Alexander et al in view of U.S. Patent 6,731,625 to Eastep et al.

Regarding claims **1, 4 and 12**, Alexander discloses the limitation of a receiver that receives a message sent via LAN by one of the telephone sets for requesting an IP address be allocated for the requesting telephone set in lines 20-23 of column 9. The receiver is inherently contained in the DHCP server; the server is implicit in the discussion of the use of DHCP. Alexander further discloses a control circuit that generates an ID and an extension of the requesting telephone sets set in case the message for requesting the IP address is received in lines 26-29 of column 9. In this case, the case where multiple extensions are assigned is assumed; the first extension discloses the extension of the claims and the other extensions disclose the ID of the claims. Alexander implicitly discloses the IP address allocation circuit that allocates the IP address of the requesting telephone set in lines 20-23 of column 9; in order for the telephony device to get an IP address, one must be allocated. Alexander discloses the limitation of a table that stores an ID, an extension and the IP address in the combination of tables 4A and 4B and as described in lines 28-35 of column 9. Alexander further discloses the limitation of a notifying unit that notifies the requesting telephone sets set of the ID, the extension and the IP address for the requesting telephone set in lines 20-23 and 26-29 of column 9. Alexander further discloses the limitation of claim 4 that one of the telephone sets (telephony device) is provided with a transmitter that transmits via LAN a message for requesting an IP address be allocated for the requesting telephone set to the telephone controller in lines 20-23 of column 9. The transmitter is implicit in that it is required to request the IP address using DHCP. Alexander further discloses the limitation of claims 1 and 4 that a telephone comprising said telephone controller can be connected by a user having no knowledge of IP and LAN in the use of DHCP as indicated above. DHCP is a protocol for automatically obtaining network information without

intervention by the user. Alexander's description (see lines 20-41 of column 9 for example)

supports this behavior. In this passage, the telephony equipment acquires the IP address "when

an IP telephony device is connected to LAN 20". The user in Alexander requires no IP or LAN

knowledge; the user must merely be capable of physically connecting the device.

Alexander does not disclose expressly the limitation that the ID, extension, and the IP

address are all stored in a single table. Alexander also does not disclose expressly the limitation

(telephone controller) that the DHCP server is collocated with the call manager 26. However, at

the time of the invention it would have been obvious to a person of ordinary skill in the art to

modify Alexander to locate the DHCP in the call manager 26 and to combine tables 4A and 4B.

The motivation for doing so would have been to reduce the overall cost of the system. In case of

locating the DHCP server in the call manager, the system would cost less due to the reduction in

the number of required network elements. In the case of combining the tables, less memory

would be required to store the information contained in the tables, as the device names would not

have to be duplicated.

Alexander, as modified above, further does not disclose expressly the limitation of claims

1 and 4 that the ID comprises a domain name. Eastep discloses a directory service for allowing a

caller to identify the IP address of a called party using a unique identifier (see lines 34-55 of

column 83). Eastep discloses the use of an email address as an identifier and also indicates that

any format can be used. By modifying one of the extensions assigned by Alexander to be an

email address, the limitation that the ID is comprised of a domain name is disclosed. Alexander

and Eastep are analogous art because they are from same field of endeavor of IP telephony. At

the time of the invention it would have been obvious to a person of ordinary skill in the art to

modify Alexander to assign an extension which is an email address. The motivation for doing so

would have been to allow the use of a familiar identifier to uniquely identify the user as implied

by Eastep in the passage cited above. Therefore, it would have been obvious to combine Eastep

with Alexander for the benefit of a familiar identifier to obtain the invention as specified in

claims 1 and 4.

Regarding claims **2 and 5**, with the parent claims 1 and 4 addressed as above, Alexander

discloses in lines 20-25 of column 9 the limitation that wherein the requesting telephone has a

user name (MAC address) and when the extension or the user name (it is well known that the

MAC address is included in the DHCP request) of the requesting telephone is included in the

message for requesting the IP address, and the control circuit generates its the ID for the

requesting telephone set based on the extension or the user name (the MAC address and the

associated device name is sent to the call manager in a registration message and the ID (the

second assigned extension) is generated based on this registration and thus based on the user

name.

Regarding claims **3 and 6**, the combination of Alexander and Eastep discussed above

discloses a directory service for allowing a caller to identify the IP address of a called party using

a unique identifier (see lines 34-55 of column 83 of Eastep). Eastep discloses the use of an email

address as an identifier and also indicates that any format can be used. By modifying one of the

extensions assigned by Alexander to be an email address, the limitation of claim 3 that the ID is

composed of a domain name, extension and user name is disclosed.

Regarding claim **7**, with parent claim 4 addressed as above, Alexander discloses the

limitation that the telephone controller in case a connection request message is sent from one of

the telephone sets, the control circuit acquires an IP address corresponding to ID by retrieving

the table using the m included in the connection request message and notifies a telephone set to

which the IP address is allocated of call incoming in elements 200-204 of Figure 5.

Regarding claims **8 and 9**, with parent claims 1 and 4 addressed as above, Alexander

discloses the limitation that a user who is not required to have knowledge of IP and LAN

connects the requesting telephone set to the LAN and the requesting telephone set automatically

acquires an ID, an IP address and an extension for the requesting telephone set in lines 20-23 and

26-29 of column 9. It is well known in the art that DHCP (Dynamic Host Configuration

Protocol) is a means of automatically assigning an IP address to a host station from a server

station. This requires the user to have no knowledge of IP or LAN technology and can happen

without his knowledge. The same is true of the extension and ID as indicated in lines 26-29 of

column 9 which indicate the call manager sending the response to the telephony device without

indicating that the user is actively involved in this transaction.

Regarding claims **10 and 11**, with parent claims 1 and 4 addressed as above, Alexander

discloses the limitation that different user names are assigned to the extension in Figure 4A

which shows extension 1002 assigned to user phone2 and phone3.

Conclusion

3.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169.

The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RCS

Robert C. Scheibel
Examiner
Art Unit 2616

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